

REMARKS/ARGUMENTS

With this amendment, claims 3-4, 6, and 56-64 are pending. Claims 1, 2, 5, and 7-55 are cancelled. New claims 63 and 64 are added. For convenience, the Examiner's rejections are addressed in the order presented in an October 13, 2006, Office Action.

Rejections under 35 U.S.C. §112, first paragraph, written description

Claims 3 and 56-62 are rejected as allegedly containing matter that was not described in the specification to convey to those of skill that the inventors had possession of the invention at the time of filing. The rejection is a new matter rejection. According to the Office Action, claim 3 is directed to a subset of nucleic acids that were not contemplated by the application as originally filed. To the extent the rejection applies to the amended claims, Applicants respectfully traverse the rejection. Furthermore, based on the Office Action, Applicants believe that the objection to claims 4 and 6 have been overcome.

According to the MPEP, there is no *in haec verba* requirement for newly added claim limitations and those limitations can be supported by express, implicit, or inherent disclosure. MPEP 2163(I)(B). As discussed below, the specification as filed provides ample support for the claimed nucleic acids.

The claims are directed to various embodiments of ADNF III nucleic acids that encode biologically active ADNF III polypeptides, *e.g.* ADNF III polypeptides that exhibit neuroprotective action on a neuron. Support for these amendments is found throughout the specification. Biologically active ADNF III polypeptides have neuroprotective properties and include full length ADNF III, subsequences, and NAP peptide. *See, e.g.*, specification at page 14, line 29 through page 15, line 5; page 27, lines 21-26; page 28, lines 25-32; and page 84, line 32 through page 85, line 6. Nucleic acids that encode ADNF III polypeptides, including NAP are disclosed at page 29, lines 9-11. Various nucleic acids that encode ADNF III polypeptides and methods to make them are disclosed at page 34, lines 15-26 and page 35, line 12 through page 36, line 5. The disclosure includes construction of nucleic acids that encode ADNF III polypeptides by systematic addition of amino acids to the NAP sequence at either end of the

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molecule. Formulas for addition of amino acids to the NAP sequence are found, *e.g.*, at page 57, line 26 though page 59, line 11 and at original claims 25-30. New claim 64 depends from claim 3 and is directed to nucleic acid molecules with 90% identity to SEQ ID NO's: 2, 4, 54, 56, or 58. Support for this amendment is found throughout the specification, for example, at page 14, lines 26-28 and page 19, lines 27-31. These amendments add no new matter.

In view of the above amendments and remarks, withdrawal of rejection for alleged lack of written description is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


Beth L. Kelly
Reg. No. 51,868

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
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